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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,488	11/15/2000	Leon Wong	13768.136.1	3606
22913	7590	06/04/2004	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			EL CHANTI, HUSSEIN A	
		ART UNIT		PAPER NUMBER
		2157		5
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/713,488	WONG ET AL.
Examiner	Art Unit	
Hussein A El-chanti	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 03 May 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-15 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Response to Amendment***

1. This action is responsive to communication received on May 3, 2004. Claims 11-14 were amended. Claims 1-15 are pending examination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Burgan et al., U.S. Patent No. 6,668,169 (referred to hereafter as Burgan).

As to claim 1, Burgan teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified (see col. 3 lines 64-col. 4 lines 7), the method comprising the following:

an act of the sending computer system identifying the user specified criteria for returning a successful acknowledgement message corresponding to the instant message to the user (see col. 13 lines 14-50, col. 7 lines 43-col. 8 lines 16 and col. 5 lines 40-45);

an act of the sending computer system determining whether the user specified criteria for returning a successful acknowledgement message are met (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16 and col. 5 lines 40-45); and

an act of the sending computer system returning a successful acknowledgment message corresponding to the instant message only if the user specified criteria have been met (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16, col. 5 lines 40-45 and col. 9 lines 28-60, an instant message is sent to the subscribers according to their portfolio existing on the server to notify the users of existence of new chat directory).

As to claim 2, Burgan teaches the method of claim 1 wherein the sending computer system comprises a sending a client computer system associated with the user (see col. 13 lines 14-50).

As to claim 3, Burgan teaches the method of claim 1 wherein the sending computer system comprises a sending client computer system associated with the user (see col. 13 lines 14-50).

As to claim 4, Burgan teaches the method of claim 3, wherein the act of the computer system identifying the user specified criteria for returning a successful acknowledgement message comprises the following:

an act of the sending server computer system receiving a data field representing the user specified criteria with the instant message (see col. 13 lines 14-50); and

an act of the sending server computer system reading the data field to identify the user specified criteria (see col. 13 lines 14-50).

As to claim 5, Burgan teaches the method of claim 1 wherein the act of the computer system identifying the user specified criteria for returning a successful acknowledgment message comprises the following:

an act of reading a data field representing the user specified criteria from a database accessible to the sending computer system (see col. 9 lines 28-60 and col. 4 lines 21-38).

As to claim 10, Burgan teaches a computer readable medium having computer executable instructions for performing the acts recited in claim 1 (see the rejection of claim 1).

As to claim 11, Burgan teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified, the method comprising the following:

an act of the sending computer system receiving an acknowledgement message for the instant message;

a step for the sending computer system determining whether user specified criteria for returning a successful acknowledgement message corresponding to the received acknowledgement message for the instant message are met (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16 and col. 5 lines 40-45); and

an act of the sending computer system returning a successful acknowledgement message corresponding to the acknowledgement message for the instant message only if the user specified criteria have been met. (see col. 13 lines 14-50, col. 7 lines 43-col.8 lines 16, col. 5 lines 40-45 and col. 9 lines 28-60, an instant message is sent to the subscribers according to their portfolio existing on the server to notify the users of existence of new chat directory)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burgan in view of La Port et al., U.S. Patent No. 6,654,359 (referred to hereafter as La Porte).

Burgan teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified (see the rejection of claim 1).

Burgan does not explicitly teach the limitation "the user specified criteria is a "single hop" criteria". However La Porte teaches an acknowledgment method in a

network where the acknowledgment criteria is "single hop" criteria (see col. 16 lines 11-50).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Burgan by incorporating the "single hop" acknowledgement criteria as taught by La Porte because doing so would allow the user to confirm that the message has been sent and that no error has occurred on the client end of the message.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgan in view of Bartfai et al., U.S. Patent No. 6,067,567 (referred to hereafter as Bartfai).

As to claim 7, Burgan teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified (see the rejection of claim 1).

Burgan does not explicitly teach the limitation "the user specified criteria is a "deep or" criteria". However Bartfai teaches a message delivery acknowledgement method according to a user specified criteria where the criteria is "deep or" criteria (see col. 2 lines 6-35).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Burgan by incorporating the "deep or" acknowledgement criteria

as taught by Bartfai because doing so would allow the user to determine if at least one of the recipients received the message rather than receiving a negative message and therefore requires the user to send less messages to the users that didn't receive the message rather than sending the message to the whole group.

As to claim 8, Bartfai teaches the method of claim 7 wherein the act of determining that at least one of the intended recipients received the instant message comprises the following:

an act of the computer system transmitting message to the next computer system in the chain of computer systems along with an indication that the user specified criteria for returning a successful acknowledgement message is that at least one of the intended recipients successfully received the instant message under the "deep or" criteria (see col. 2 lines 6-35);

an act of the computer system receiving an acknowledgement message from the next computer system in the chain of computer systems indicating whether or not at least one of the intended recipients successfully received the instant message under the "deep or" criteria (see col. 2 lines 6-35); and

an act of the computer system determining that at least one of the intended recipients has received the instant message if the acknowledgment message from the next computer system indicates that at least one of the intended recipients successfully received the instant message under the "deep or" criteria (see col. 2 lines 6-35).

As to claim 9, Bartfai teaches the method of claim 1 wherein the user specified criteria is a "deep and" criteria, and

the act of the sending computer system determining whether the user specified criteria for returning a successful acknowledgement message are met comprises an act of the sending computer system determining that all of the intended recipients successfully received the instant message under the "deep and" criteria (see col. 1 lines 40-50).

5. Claims 12-15 do not add or define any additional limitation over claims 1-11 and therefore are rejected for similar reasons.

6. Applicant's arguments filed have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that; A) Burgan does not teach acknowledging delivery of an instant message where the criteria for determining success or failure of delivery are user specified.

In response to A) Burgan teaches a method of chat between clients where a user has the option of choosing between 1) guaranteed delivery option and 2) non-guaranteed delivery option (see col. 7 lines 35-40). If the user selects the guaranteed delivery option, the chat server queries for an acknowledgement. When no user acknowledgement has been received, the chat server continues to query for a user acknowledgement (see col. 8 lines 1-15). There are no limitations on the user specified criteria for returning a successful message and therefore user guaranteed delivery option of Burgan meets the scope of the claimed limitation "an act of the sending computer system identifying the user specified criteria for returning a successful acknowledgement message corresponding to the instant message to the user".

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**8.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

May 27, 2004



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